



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,612	06/28/2000	Bruce D. Lucas	6169-142	5855

40987 7590 02/02/2005

AKERMAN SENTERFITT
P. O. BOX 3188
WEST PALM BEACH, FL 33402-3188

EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,612

Applicant(s)

LUCAS ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE with the affidavit under 37 CFR 1.131 filed 12/14/04 to the application filed on 6/28/00.
2. Claims 1-27 are pending in the case. Claims 19-21 have been withdrawn from consideration. Claims 1, 6, 10, 15, 19, 22, 25 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-18, 22-27 remain rejected under 35 U.S.C. 102(e) as being anticipated by Wesemann et al. (US Pat No. 6,349,132 B1, 2/19/02, filed 12/16/99).

Regarding independent claim 1, Wesemann discloses:

- retrieving a network-based document formatted for in the Visual Browser (figures 3-5; col 3, line 33 to col 4, line 6)
- identifying in the retrieved document a reference to the Voice Browser, said reference specifying electronic content formatted for audible presentation in the Voice Browser (figures 3-4; col 5, lines 12-38)

- transmitting said reference to the Voice Browser (figure 3: transmitting HTML documents in the HTML source #310 to the Voice Browser #340; col 5, lines 27-38: the system identifies the links in a document and provides users with an audio representation of the document text)
- the Voice Browser retrieving said specific electronic content and audibly presenting said electronic content in the Voice Browser (figures 3-5: the document is retrieved and played audio of text after the text to speech translating; col 5, lines 27-38)
- the Visual Browser visually presenting said network-based document concurrently with said audible presentation (col 6, lines 18-36: "Voice Browser #340 could be used in conjunction with Visual Browser #320 to provide simultaneously visual and audio interfaces..."; col 2, lines 20-37)

Regarding claim 2, which is dependent on claim 1, Wesemann discloses that the network-based document formatted for visual presentation in the Visual Browser is an HTML formatted document and the Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 3, which is dependent on claim 1, Wesemann discloses that said electronic content formatted for audible presentation in the Voice Browser is VoiceXML formatted electronic content (col 5, lines 20-53).

Art Unit: 2178

Regarding claim 4, which is dependent on claim 2, Wesemann discloses that said reference is a coordination markup attribute (col 2, lines 20-30 and col 8, lines 24-36: elements in the tags of a markup document include a markup attribute).

Regarding claim 5, which is dependent on claim 1, Wesemann discloses that said reference specifies a network-based document containing said electronic document formatted for audible presentation in the Voice Browser (col 5, lines 27-38) whereby the Voice Browser can retrieve said specified network-based document through the computer communications network and audibly present said electronic content contained in said specified network-based document, while the Visual Browser can visually present said network-based document formatted for visual presentation (col 6, lines 18-36; col 2, lines 33-37).

Regarding independent claim 6 and its dependent claims 7-9, the claims are merely the opposite way to retrieve and present a network-based electronic document. Wesemann discloses accessing network-based electronic content in both a Voice Browser and a Visual Browser where the web document is *displayed and presented simultaneously in the Voice Browser and the Visual Browser*. Wiseman, therefore, inherently discloses the both ways of presentation a web document in an audio interface and a visual interface (col 3, line 33 to col 4, line 6).

Claims 10-14 are for a machine readable storage of method claims 1-5, and are rejected under the same rationale.

Claims 15-18 are for a machine readable storage of method claims 6-9, and are rejected under the same rationale.

Regarding independent claim 22, Wesemann discloses:

- incorporating visual content in a network-based document (figures 7-8; col 2, lines 38-52; col 3, lines 33-47)
- formatting said network-based document for visual presentation in a Visual Browser (col 3, lines 23-47)
- inserting at least one markup tag in said network-based document, said markup tag containing a coordination markup attribute specifying a network-based document formatted for audible presentation in a Voice Browser (col 2, lines 20-30, col 8, line 24-36 and col 5, lines 11-37: the fact that a markup tag in the HTML codes of a web document can be used to identify a category in the web document presentation where the text document can be played in the audio interface indicates that a markup tag can be inserted to the HTML codes for specifying the audio presentation of the web document)
- whereby the Visual Browser when rendering said network-based document formatted for visual display can identify said coordination markup attribute in said markup tag and can transmit a reference to said specified network-based

document and audibly present said specified network-based document concurrently with the visual presentation of said network-based document formatted for visual presentation in the Visual Browser (col 3, line 48 to col 4, line 6 and col 6, lines 18-36)

Regarding claim 23, which is dependent on claim 22, Wesemann discloses that said network-based document formatted for visual presentation in a Visual Browser is an HTML formatted document and said Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 24, which is dependent on claim 22, Wesemann discloses that said network-based document formatted for audible presentation in a Voice Browser is a VoiceXML formatted document and said Voice Browser is a VoiceXML Browser (col 2, lines 20-53, figures 1, 3, col 6, lines 18-36).

Regarding independent claim 25, Wesemann discloses:

- incorporating voice content in a network-based document (col 5, lines 11-38)
- formatting said network-based document for audible presentation in a Voice Browser (col 6, lines 18-63)
- inserting at least one markup tag in said network-based document, said markup tag containing a coordination markup attribute specifying a network-based

document formatted for visual presentation in a Visual Browser (col 7, lines 10-53 and figures 6-9: the displayed web document as seen is encoded by the markup tags containing the markup attribute for a visual presentation of the web document; col 8, lines 23-36)

- whereby the Voice Browser when rendering said network-based document formatted for audible display can identify said coordination markup attribute in said markup tag and can transmit a reference to said specified network-based document and visually present said specified network-based document concurrently with the audible presentation of said network-based document formatted for audible presentation in the Voice Browser (col 10, lines 21-63; figures 5, 11; col 6, lines 18-36)

Regarding claim 26, which is dependent on claim 25, Wesemann discloses that said network-based document formatted for visual presentation in a Visual Browser is an HTML formatted document and said Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 27, which is dependent on claim 25, Wesemann discloses that said network-based document formatted for audible presentation in a Voice Browser is a VoiceXML formatted document and said Voice Browser is a VoiceXML Browser (col 2, lines 20-53 and col 10, lines 21-63).

Response to Amendment

5. The affidavit filed 12/14/04 and the declaration filed 4/10/04 under 37 CFR 1.131 have been considered but are ineffective to overcome the Wesemann reference (6,349,132).

6. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wesemann reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Regarding conception, the declaration does not support the claimed limitations. *An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). See MPEP 715.07.

Also, the affidavit, though shows that the invention was complete on 11/11/99, the affidavit does not show how the invention disclosure in the Exhibit is mapped with the claims of the application. *It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.*); *Hybritech Inc. v. Monoclonal*

Antibodies Inc., 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986). See MPEP 2138.04.

7. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wesemann reference to either a constructive reduction to practice or an actual reduction to practice.

Regarding due diligence, the affidavit and the declaration fail to provide a timeline with details of the facts where the invention had been prepared since 11/11/99, prior the effective filing date of Wesemann 12/16/99, to the filing date of the invention 6/28/00. Statements as "In the above-identified patent application, this decision was made and outside counsel was instructed to prepare an application on November 29, 1999. The above-identified patent application was filed June 28, 2000" or "due diligence was exercised from November 11, 1999 through June 28, 2000 , the filing date for the above-identified patent application" are merely general statements and are not enough to prove the diligence. Applicants must show how the evidence supports the diligence from prior the effective date of the reference to the filing date of the application. *An applicant must account for the entire period during which diligence is required. Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that **there were no weeks or months that the invention was not worked on is not enough.**); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading**). **A 2-day period lacking activity has been held to be**

***fatal.** In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts.**). **The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.** Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses; Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence). See MPEP 2138.06.*

Applicant's attention is directed to MPEP 715.09 regarding timely submission of an affidavit or declaration under 37 CFR 1.131.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thum et al. (US Pat No. 6,616,700 B1, 9/9/03, filed 1/7/00).

Bates et al. (US Pat No. 6,732,142 B1, 5/4/04, filed 1/25/00).

Tsakiris et al. (US Pat App Pub No. 2001/0034746 A1, 10/25/01, filed 2/23/01, priority 2/26/00).

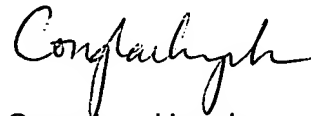
Dutta et al. (US Pat App Pub No. 2003/0164848 A1, 9/4/03, filed 3/1/01).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
01/27/05